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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,317	02/08/2002	Steven Brian Johnson	205,510	3702

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Abelman Frayne & Schwab
150 East 42nd Street
New York, NY 10017

EXAMINER	
COBURN, CORBETT B	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding. .

Office Action Summary	Application No.	Applicant(s)	
	10/049,317	JOHNSON, STEVEN BRIAN	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-60* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 17-19 & 24-26, 29-34, 44, 45-50 & 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Bueschel (*Lemons, Cherries and Bell-Fruit-Gum*, Royal Bell Books, 1995).

Claims 1, 17, 24, 29 & 45: Bueschel teaches a Puck gaming machine that was introduced in 1898. The probability of winning a prize is dependent on at least some of the amount wagered on the gaming machine. As the illustration clearly shows, there are six coin slots available for the player to make a bet. Each slot corresponds to a color on the wheel. A player may place a bet in any or all of the slots. Thus the more money bet, the greater the odds that the player will win because more colors will generate a win. A control means is inherent in the gaming machine and each spin of the wheel is one of a series of draws. The prize is awarded at random (i.e., non-deterministically). The bets are made for each spin of the wheel. There is an elapsed period of time between spins.

Claims 2, 18, 25, 30, 46: The probability is related to the total amount wagered between spins.

Claim 3, 31 & 47: The probability is related to the maximum amount wagered.

Claims 4, 19, 26, 32, 48: The time between spins is variable (i.e., sliding or rolling).

Claim 5, 33, 49: Each spin is a prize draw. Payouts are in accordance with the pay table. Thus the probability of the gaming machine winning is inherently calculated prior to the draw.

Claim 6, 34, 50: The elapsed period is the period between spins. While the time in minutes and seconds may not be predetermined, the period is – the time since the last spin. The amount wagered is recorded for that time period and the probability of the gaming machine winning is inherently calculated prior to the draw from amounts recorded during the period.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 9, 11-15, 22, 23, 28, 37, 39-43, 53 & 5-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bueschel as applied to Claim 1, 5, 17, 24, 29, 33, 44, 45, 49 or 60.

Claim 9, 37, 53: The Puck machine teaches the invention substantially as claimed, but does not teach awarding the winning machine a further game to determine the prize won. Bonus games are extremely well known to the art. They are very well known to attract players. On page 248, Bueschel teaches the Bally Circus. The Bally Circus uses a further game to determine the prize won. It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified the Puck Machine to

award the winning machine a further game to determine the prize won as taught by the Bally Circus in order to attract players.

Claim 11, 39, 55: The Bally Circus awards a jackpot and suspends the award until the determination of the further game.

Claim 12, 40, 56: The Puck game machine teaches the invention substantially as claimed, but does not teach a jackpot pool. Jackpot pools are extremely well known in the art. Bueschel (on page 43) teaches that the Mills Duplex machine was introduced in 1899. The Mills Duplex operates under the same principle as the Puck, but adds jackpot pools. Jackpot pools are well known to attract players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Puck Machine to include jackpot pools (as they did for the Mills Duplex) in order to attract players.

Claim 13, 41, 57: The Mills Duplex jackpot pool comprises an initial amount (it could be zero) and a proportion of the amount wagered on the gaming machine since the jackpot pool was reset. Furthermore, Bueschel teaches auto-filling jackpots on page 90.

Claims 14, 23, 28, 42, 58: The Puck advertisement shows a pay table displaying a graphical representation of the probability of the gaming machine winning a prize. It appears that this information is displayed on the coin heads, but the quality of the illustration precludes a certain determination. Display of pay tables (i.e., graphical representation of the probability of a machine winning) is extremely well known in the art. It helps the user determine what bet to place. The Little Monte Carlo, offered by Mills in 1899, clearly shows a paytable. It would have been obvious to one of ordinary

skill in the art at the time of the invention to have displayed a graphical representation of the probability of the gaming machine winning a prize on a Puck Machine as taught by the Little Monte Carlo in order to help the user determine what bet to place.

Claim 15, 43, 59: The Puck and Little Monte Carlo Machines teach the invention substantially as claimed. The Little Monte Carlo displays probabilities in a relative format. Neither Puck nor Little Monte Carlo teaches a system with a plurality of gaming machines. This is very old and well known to the art. For instance, on 287, Bueschel teaches multiple linked gaming machines. This allows the gaming machines to share a single large jackpot. Large jackpots attract players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Puck and Little Monte Carlo machines to include a plurality of gaming machines (as taught on page 287 of Bueschel) in order to allow the machines to share a single large jackpot in order to attract players.

Claim 16, 22: The Puck is a mechanical game machine – it is not electronic. Electronic gaming machines are tremendously well known in the art. Some of the earliest gaming machines were electric – Bueschel discloses an electronic color wheel operating on the same principle as the Puck Machines that was introduced in 1893 (Pratt's Electric Wizard). Thus electronic gaming machines had been used for over a century before Applicant's invention.. The early electronic machines had problems – electricity was not readily available to all locations in 1893 and electric motors were in their infancy. But these problems have long since been overcome. Mechanical slot machines went out of vogue in the mid-1950's – approximately 50 years before Applicant's invention.

Electronic slot machines are now the industry standard and have been for decades. Electronic slot machines are easier to maintain than mechanical slot machines. They are also less prone to fraud. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Puck Machine to be an electronic game machine in view of Bueschel in order to make the machine easier to maintain.

5. Claims 7, 8, 35, 36, 51, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bueschel as applied to claim 6, 34 or 50 above, and further in view of Luciano et al. (US Patent Number 6,168,521).

Claim 7, 35, 51: Bueschel teaches the invention substantially as claimed, but does not teach drawings being conducted at periodic intervals of time that are no greater than a predetermined time period. The Puck machine is essentially a lottery machine and each color bet upon is essentially a lottery ticket. Luciano teaches a gaming system in which drawings are conducted at periodic intervals of time that are no greater than a predetermined time period. (Col 3, 1-5) This allows players to use electronic gaming machines in jurisdictions in which slot machines are not normally permitted. (Col 1, 4-19) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Puck machine to conduct drawings at periodic intervals of time that are no greater than a predetermined time period as suggested by Luciano in order to allow the game machines to be played in jurisdictions in which slot machines are not normally permitted.

Claim 8, 36, 52: The winning probability for each gaming machine depends upon the amount wagered on the machine during the period from the last draw – players bets do

not carry over from game to game. The estimated amount is calculated on a pro rata basis from the recorded amount of wagers during the predetermined period – players only get credit for the bets they place on the machine.

6. Claim 10, 38, 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bueschel as applied to claim 9, 37 or 53 above, and further in view of Acres (US Patent Number 6,231,445).

Claim 10, 38, 54: Bueschel teaches the invention substantially as claimed, but does not teach a time limit on the bonus game. Acres teaches a time limit for bonus games. (Fig 4) This increases the excitement of the game. It would have been obvious to one of ordinary skill in the art to have modified the bonus game taught by Bueschel to impose a time limit on the bonus game as taught by Acres in order to add excitement to the game.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bueschel as applied to claim 17 above, and further in view of Barrie et al. (US Patent Number 4,837,728)

Claim 21: Bueschel teaches the invention substantially as claimed but does not teach a jackpot controller and a progressive jackpot. Jackpot controllers and progressive jackpots are extremely well known to the art. (Class 463/27 is devoted entirely to progressive jackpots and jackpot controllers.) Barrie provides one example. (Abstract & Fig 3) Progressive jackpots are well known to attract players. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bueschel to include a jackpot controller and a progressive jackpot as taught by Barrie in order to attract players.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bueschel as applied to claim 26 above, and further in view of Castellano et al. (US Patent Number 5,477,952).

Claim 27: The Puck teaches the invention substantially as claimed, but does not specifically teach a means for recording during the predetermined period amounts wagered on the gaming machine. While the Puck may be said to inherently record the number of coins bet during the time period because it has to know what colors are bet on, the Puck does not actually keep a record of the number of coins bet. Coin-in meters that do keep such records are, however, extremely well known to the art. In fact, they are commonplace. In order to operate, each and every slot machine is required by law to have such a meter. Castellano teaches a coin-in meter. (Fig 4A) Coin-in meters allow casinos to keep track of how much money a slot machine takes in. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Puck to include a coin-in meter (to record during the predetermined period amounts wagered on the gaming machine) as suggested by Castellano in order to allow the casino to keep track of the money bet in a slot machine in order to comply with applicable law.

Newly Added Claims

9. With respect to newly added claims, 28-60, Applicant has stated that they are not patentably distinct from the corresponding original claims. The claims have, therefore been rejected with their corresponding claims. Had the claims been patentably distinct, they would not have been entered due to Applicant's election by original presentation.

Response to Arguments

10. Applicant's arguments filed 25 June 2004 have been fully considered but they are not persuasive.

11. Applicant argues that the probability of winning a jackpot is determined by (1) the amount wagered and (2) and elapsed time period having a starting point and finishing point (i.e., a predetermined time period). This is not commensurate with the scope of the claims. The claims do not contain any mention of a predetermined time period. Had they done so, the prior art would still be applicable. The chances that a person will win a slot machine game during a predetermined inherently depend on the number of times the game is played during that time period. For instance, if the time period is 1 hour, the player that plays the game 100 timed during that hour has a greater likelihood of winning than a player who plays 50 times. This is an inherent property of the gaming machine and arises from the application of the laws of probability. If the chances that a player receives a particular results is 1 in 1000, then the player that plays 100 times has twice the odds of winning as the player who only plays 50 times.

12. Applicant's arguments concerning the "basic prior art system" are moot. Applicant's arguments must address the particular prior art systems applied. Examiner will, however, note that the particular prior art system **does** change the probability with the amount bet.

13. Applicant argues that on multiple line gaming machines, each line is a separate game. Again, this argument does not address the particular prior art applied. Examiner notes that he interprets that term "game" to include each activation of the gaming machine – not each payline. Examiner believes that this is a reasonable interpretation that would be accepted by most practitioners of the art.

14. Applicant's discussion of the different types of jackpots, though greatly edifying, is moot. These arguments do not address the particular art applied. Applicant's arguments that these various prior art jackpot systems do not determine the probability by reference to the two factors mention above is addressed above.

15. Applicant argues that Bueschel fails to teach determining the odds with reference to a predetermined time period. Applicant provides information concerning the Australian Federal Court's interpretation of "during and elapsed time period". The decisions of the Australian Federal Court are not binding upon this office. As noted above, Applicant's arguments are not commensurate with the scope of the claims.

16. Applicant remarks that lotteries are not time dependent. Applicant misunderstands the Examiner's remarks. Applicant claims that the odds of winning depend on the amount wagered during an elapsed time. In the US, there are lotteries that are drawn on a daily basis. The elapsed time period between draws is 24 hours. The more tickets a person buys (i.e., the more money wagered) during that 24 hours, the greater the player's chances of winning. This is essentially what Applicant is claiming. This is why Examiner said that the claims were extremely broad. Applicant does **not** claim that the odds change based on a time factor. Applicant merely claims that the odds change based on the amount bet during an elapsed time. This is not a "pioneer invention" as claimed.

17. Applicant argues that the Federal Court in Australia has reviewed the prior art and has determined that the case is patentable. Examiner needs hardly mention that the decisions of the Australian Federal Court have no bearing on this Office's decisions in regard to patentability.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cbc

JESSICA HARRISON
PRIMARY EXAMINER